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10/524,567

02/11/2005

Guy Zins

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EXAMINER

FERGUSON, MICHAEL P

ART UNIT

PAPER NUMBER

3679

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
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3 MONTHS

12/29/2006

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/524,567

Applicant(s)

ZINS, GUY

Examiner

Michael P. Ferguson

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-44 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 30-44 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>02/11/05, 05/18/05, 08/10/06</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

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Claim Objections

3. Claims 30,32-34,36 and 38 are objected to because of the following informalities:

Claim 30 (line 3) recites "with a first part". It should recite --the joining connection comprising a first part--.

Claim 32 (line 3) recites "the separating line". It should recite --a separating line--.

Claim 33 (line 2) recites "channels are having faces rising up to the wall section". It should recite --channels have faces rising up from the wall sections--.

Claim 34 (line 1) recites "wherein the faces". It should recite --wherein each set of faces--.

Claim 36 (line 3) recites "hardens to rings". It should recite --hardens to form rings--.

Claim 38 (line 4) recites "this part". It should recite --said one part--.

For the purpose of examining the application, it is assumed that appropriate correction has been made.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 30,35,40 and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 30 (line 2) recites "in particular of operating rams such as props for underground mining". The phrase "in particular" renders the claim indefinite as it is unclear as to what is positively claimed as the invention.

Claim 35 (line 2) recites the limitation "the longer face of the wall section". There is insufficient antecedent basis for this limitation in the claim.

Claim 35 (line 2) recites "in particular is 30 degrees". The phrase "in particular" renders the claim indefinite as it is unclear as to what is positively claimed as the invention.

Claim 40 (line 2) recites "in particular a polyamide or a polyphenylether or a polyterephthalate, in particular a polybutyleneterephthalate, or a polyvinylidenefluoride". The phrase "in particular" renders the claim indefinite as it is unclear as to what is positively claimed as the invention.

Claim 41 (line 2) recites "in particular a glass fibre-reinforced casting compound". The phrase "in particular" renders the claim indefinite as it is unclear as to what is positively claimed as the invention.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 30-38, 40 and 42-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Baumann (US 5,606,839).

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As to claim 30, Baumann discloses a joining connection capable of use with functional parts of hydraulic or pneumatic operating devices, the joining connection comprising a first part **18,20** having an outer wall section and a second part **32** having an inner wall section, which parts can be joined together and connected to each other with mutually overlapping wall sections, with the sections are overlapping with a transition fit or a clearance fit, wherein both wall sections comprise a depression, which in the connected state form a cavity being filled with a casting compound of plastic **50**, which is plasticized and fluid and connects the two parts to each other by means of a positive form fit, and wherein one of the parts comprises a filling or injection opening **40** for the casting compound, which opening leads via a casting channel into the corresponding depression (Figures 7,8).

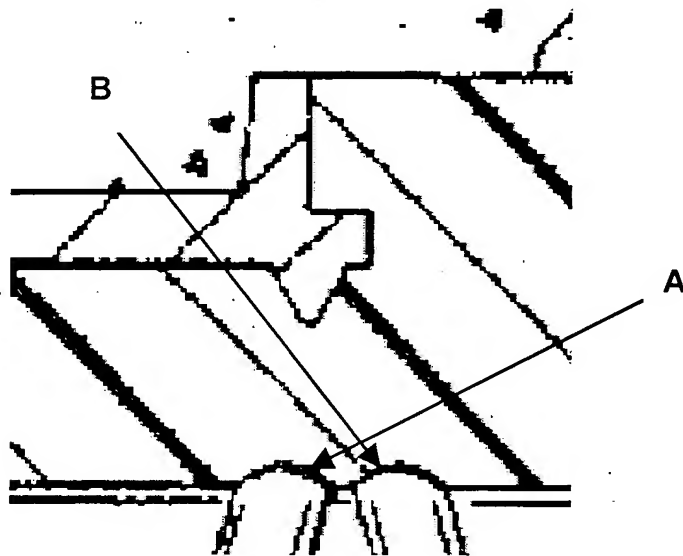
As to claim 31, Baumann discloses a joining connection wherein both wall sections comprise a plurality of depressions (Figures 7,8).

As to claim 32, Baumann discloses a joining connection wherein the depressions consist of circumferential corrugations, grooves or channels, which are aligned at right-angles to the separating line between the parts (perpendicular to the longitudinal axis; Figures 7,8).

As to claim 33, Baumann discloses a joining connection wherein the corrugations, grooves or channels each comprise a set of faces rising up from the wall section (Figures 7,8).

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As to claim 34, Baumann discloses a joining connection wherein each set of faces A,B (Figure 7 reprinted below with annotations) are angled at right-angles to each other (the tangents of faces A,B are perpendicular to each other).



As to claim 35, Baumann discloses a joining connection wherein an angle of inclination of one of the faces A,B of each set of faces is 25 to 35 degrees relative to the longitudinal axis (Figures 7,8).

As to claim 36, Baumann discloses a joining connection wherein the corrugations, grooves or channels are arranged in the wall sections of both parts **18,20,32** such that the casting compound **50** solidifies or hardens to form rings with right-angled cross-sections (perpendicular to the longitudinal axis; Figures 7,8).

As to claim 37, Baumann discloses a joining connection wherein adjacent depressions in the wall sections are separated from each other by a web, and in the assembled state the webs of the wall sections of the first **18,20** and second **32** parts lie directly opposed to each other (Figures 7,8).

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As to claim 38, Baumann discloses a joining connection wherein the depression of the wall section of one of the parts **32** leads into a feeder channel **40** to an annular space, adapted to be filled with the casting compound **50** in order to cast a guide sleeve for the part itself (Figures 7 and 8).

As to 40, Baumann discloses a joining connection wherein the casting compound **50** is a thermoplastic.

As to claim 42, Baumann discloses a joining connection wherein the joining connection may be separated.

Applicant is reminded that **process limitations are given little patentable weight in product claims** since the patentability determination of product-by-process claims is based on the product itself, even though such claims are limited and defined by the process. See MPEP § 2113. "The patentability of a product does not depend on its method of production." In re Thorpe, 777 F.2d 695,698,USPQ 964,966 (Fed.Cir.1985).

As to claim 43, Baumann discloses a joining connection wherein the joining connection may be separated.

Applicant is reminded that **process limitations are given little patentable weight in product claims** since the patentability determination of product-by-process claims is based on the product itself, even though such claims are limited and defined by the process. See MPEP § 2113. "The patentability of a product does not depend on its method of production." In re Thorpe, 777 F.2d 695,698,USPQ 964,966 (Fed.Cir.1985).

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As to claim 44, Baumann discloses a joining connection wherein the joining connection may be separated.

Applicant is reminded that **process limitations are given little patentable weight in product claims** since the patentability determination of product-by-process claims is based on the product itself, even though such claims are limited and defined by the process. See MPEP § 2113. "The patentability of a product does not depend on its method of production." In re Thorpe, 777 F.2d 695,698, USPQ 964,966 (Fed.Cir.1985).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baumann.

As to claim 39, Baumann fails to disclose a joining connection wherein the casting compound of plastic in the hardened or solidified state withstands shear force loads of at least 45 N/mm².

The applicant is reminded that the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the

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invention was made to modify a joining connection as disclosed by Baumann wherein the casting compound of plastic in the hardened or solidified state withstands shear force loads of at least 45 N/mm^2 because it would be expected that one of ordinary skill in the art would routinely experiment to arrive at the optimum or workable strength characteristics for a given application and select a material based upon such optimum strength characteristics.

10. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baumann in view of DeJong (US 5,037,234).

As to claim 41, Baumann fails to disclose a joining connection wherein the casting compound is a fiber-reinforced casting compound.

DeJong teaches a joining connection wherein a casting compound is a fiber-reinforced casting compound; the fiber-reinforcement providing for a stronger, more durable connection (column 4 lines 59-61). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify a joining connection as disclosed by Baumann wherein the casting compound is a fiber-reinforced casting compound as taught by DeJong in order to provide for a stronger, more durable connection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to the applicant's disclosure. The following patents show the state of the art with respect to joining connections:

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Bauer et al. (US 4,127,741), Guntermann (US 3,638,978), Ashida et al. (US 4,752,151) and Goto (US 6,200,061) are cited for pertaining to connections comprising first and second parts connected by a casting compound.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael P. Ferguson whose telephone number is (571)272-7081. The examiner can normally be reached on M-F (8:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571)272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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